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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,910	11/21/2003	Hiroyuki Takahashi	50049-041	7364
20277	7590	01/10/2007	EXAMINER	
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			HYUN, PAUL SANG HWA	
			ART UNIT	PAPER NUMBER
			1743	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/10/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/717,910	TAKAHASHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Paul S. Hyun	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 21 November 2003.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-8 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-8 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 21 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 3/5/04, 4/16/04

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the radial slits recited in the claims must be shown or the feature canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 3 and 6 are objected to because of the following informalities:

“a elastic “ in line 2 of claim 3 should be changed to “an elastic”.

“has” in line 2 of claim 6 should be changed to “comprises”.

Appropriate corrections are required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation “the sealing member made of a elastic plate having a specified thickness”. There is insufficient antecedent basis for this limitation in the claim. Neither claim 1 nor claim 2 has previously established that the sealing member has a specified thickness.

Claim 2 recites the limitation “the outer periphery” with respect to many elements. The claim must specify to which element each of “the outer periphery” refers. For example, it is not clear whether “the outer periphery” recited in line 9 of claim 2 is referring to the outer periphery of the opening of the vessel body, or the outer periphery of the sealing member.

Moreover, the limitations “upper outer periphery” and “lower outer periphery” recited in claim 2 should be changed to “the upper **region of the outer periphery**” and “the lower **region of the outer periphery**”, respectively. The terms as recited in the

claims can be mistakenly interpreted to be separate elements from the “outer periphery”.

The limitations “an outer cylinder provided around the outer periphery of the substrate as its inner periphery being in contact” and similarly “an inner cylinder provided along the through hole as its outer periphery being in contact” recited in claim 2 are unclear. It is not clear whether Applicants intended the limitations to mean, for example, “an inner cylinder provided along the through hole as its outer periphery [being] is in contact” or “an inner cylinder provided along the through hole as its outer periphery, wherein the inner cylinder is [being] in contact”.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 8** is rejected under 35 U.S.C. 102(b) as being anticipated by Shaw, Jr. (US 4,427,110).

Shaw, Jr. discloses a receptacle for diapers and a method for its use (see Figs. 4 and 5). The receptacle comprises an elastic sealing member 20 comprising a cap body in the form of flange 28 and radial slits that extend to the edges of the sealing member to form sectors 26. The container further comprises a pressurizing member 30 situated above the sealing member and designed to pivot about yoke 16. In the closed position,

plunger 34 of pressurizing member 30 biases the sectors 26 in the downward, expanded position. When the pressurizing member is pivoted about yoke 16 to the open position, the sectors spring into the plane of the sealing member 20 (see line 55, col. 2-line 10, col. 3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw, Jr. in view of Pamment (US 4,456,141).

The receptacle disclosed by Shaw, Jr. differs from the claimed invention in that the receptacle lacks a spring member. Pamment discloses a waste receptacle comprising a hinged lid 21 wherein the lid is spring-biased to facilitate the hinged movement (see lines 15-20, col. 2). In light of the disclosure of Pamment, it would have

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been obvious to one of ordinary skill in the art to provide the pressurizing member 30 disclosed by Shaw, Jr. with a spring so that its hinged movement can be facilitated.

With respect to claim 3, although Figure 5 of the reference shows that sealing member 20 comprises eight sectors, it would have been obvious to one of ordinary skill in the art to modify the number of sectors to optimize the level of elasticity/stiffness of the sectors. In this instance, it would have been obvious to provide the sealing member 20 with four sectors instead of eight to enhance the stiffness and hence the closing ability of the sealing member when the pressurizing member 30 is removed from the sealing member.

#### ***Allowable Subject Matter***

Claims 2 and 5-7 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

Shaw, Jr. (US 4,427,110) discloses a container for handling diapers. It comprises a sealing member having radial slits that define sectors, and a pressurizing member adapted to urge and maintain the sectors of the sealing member in the open position when the pressurizing member is inserted through the plane of the sealing member. However, the pressurizing member disclosed by Shaw, Jr. does not comprise a through hole, which is an essential feature of the claimed invention. The through hole of the claimed invention allows the user to gain access to the inside of the container while the pressurizing member is inserted through the plane of the sealing member. The

incorporation of a through hole to the pressurizing member disclosed by Shaw, Jr. also would not have been obvious because the pressurizing means disclosed by Shaw, Jr. must be a solid member to perform its intended function of pushing articles through the slotted sealing member.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul S. Hyun whose telephone number is (571)-272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PSH  
1/3/07

  
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